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Harry
Aug. 23, 01
Docket No. 13761-0727

Certificate of Mailing/Transmission (37 C.F.R. § 1.8(a)):

[X] Pursuant to 37 C.F.R. § 1.8, I hereby certify that this paper and all enclosures are being deposited with the United States Postal Service as first class mail on the date indicated below in an envelope addressed to the Assistant Commissioner for Patents, Washington D.C. 20231.

[] Pursuant to 37 C.F.R. § 1.6(d), I hereby certify that this paper and all enclosures are being sent via facsimile on the date indicated below to the attention of Examiner _____ at Facsimile No. _____ at _____ a.m./p.m.

Dated: August 15, 2001

Name of Person Certifying:

Printed Name: Laer Barrett

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter C. Brooks, et al.

Assignee: University of Southern California

Filing Date: 01/06/2000

Examiner: Harris, A.

Serial No.: 09/478,977

Group Art Unit: 1642

Title: METHOD AND COMPOSITION FOR ANGIOGENESIS INHIBITION

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Assistant Commissioner for Patents
Washington, D.C. 20231

A petition for a one-month extension of time accompanies this response.

This is in response to the restriction requirement set forth in the Office Action mailed on June 21, 2001. In the Office Action, the Examiner identified four claim groups and required the election of one claim group for prosecution in the present application. The four claim groups are as follows:

- I. Claims 1-4 and 6-18, "drawn to an antagonist that specifically binds to a denatured collagen or collagens, classified in class 530, subclass 350."
- II. Claims 20-25, 27-30, 32-34, 36-38, 40-42 and 60-64, "drawn to a method of inhibiting angiogenesis comprising administering an antagonist to a tissue, classified in class 514, subclass 1."
- III. Claims 43-55, "drawn to a method for screening for denatured collagen antagonists comprising providing a putative antagonist, classified in class 435, subclass 7.1."

IV. Claims 56-59, "drawn to a peptide, classified in class 530, subclass 300."

Applicants hereby elect Group I, Claims 1 to 4 and 6-18, with denatured collagen type-I as the species for examination with traverse, and requests reconsideration of the requirement for the following reasons.

The Commissioner may require restriction only when the inventions are independent or distinct, and examination without restriction presents a serious burden to the examiner. See MPEP § 803. Examiners must provide reasons and/or examples to support their conclusions regarding the status of the inventions and the seriousness of the burden. Id. Applicants respectfully submit that a review of the specification and the claims indicates that the four claim groups identified by the Examiner are closely linked as a unitary invention and should be examined together, notwithstanding the Examiner's assertion to the contrary.

The Examiner erroneously asserts that the inventions "of Group I and Groups II and III are related as process of making and product made." OA at page 2. Group I and Group II claims are not related as such. Group I claims are directed to a product and Group II claims are directed to a process of using the product and not to a "process of making" the product, as the Examiner incorrectly assumes. Because the Examiner has not recognized the proper relationship between the claim groups, needless to say, the Examiner has failed to make the requisite showing for imposing a restriction between these two groups.

Because Groups I and II are related as a product and method of using the product, as such, there is a close parity between the claims of the two groups. It should be noted that, MPEP 806.05(h) states that to show that a product and method of using that product are distinct inventions, one or both of the following should be shown: (1) the process as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process. Because the Examiner did not recognize the relationship, the Examiner did not make the requisite showing. Without such a showing, and because there is a close correspondence between the process of use and product claims of Groups II and I, respectively, restriction between these two groups is not proper.

According to the MPEP guidelines designed to determine whether inventions are *independent* from others, the term "independent" means that there is no disclosed relationship between the subject matter, that is, "they are unconnected in design, operation, or effect." See MPEP § 802.01. Examples of independent combinations are "an article of apparel such as a shoe, and a locomotive bearing," or "a process of painting a house and a process of boring a well." See MPEP § 806.04. As noted above, Claim Groups I and II are related to each other because they both relate to the antagonists of claim 1.

For all of the foregoing reasons, Applicants respectfully submit that the inventions of Groups I and II are closely related and not independent and, therefore, there is no basis for imposing upon Applicants the added expense of filing and prosecuting an additional application. Applicants, therefore, respectfully request reconsideration of the restriction requirement between Claim Groups I and II, and ask that it be withdrawn, and further request an action on the merits and a notice of allowance.

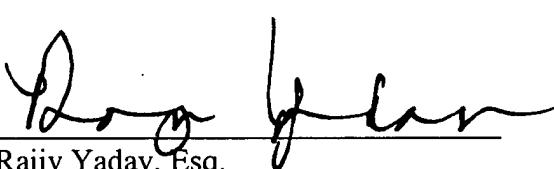
The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 50-1192.

Dated: August 15, 2001

Respectfully submitted,

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